UNITED STATES PATENT AND TRADEMARK OFFICE

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10/619,377	07/14/2003	Jouko Tenhunen	NOKM.058PA	5425

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EXAMINER

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ART UNIT	PAPER NUMBER
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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 July 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)   Paper No(s)/Mail Date *02/27/04*.

4) ☐ Interview Summary (PTO-413)   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to the application filed on July 14, 2003. Claims

1-22 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Claims 18 and 22 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. Claims 18 and 22 recite "A

computer-readable medium....." computer-readable medium is not limited to

tangible medium.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.   Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

Claim 17 recites the limitation "its" in line 2. There is insufficient

antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors

Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology

Technical Amendments Act of 2002 do not apply when the reference is a U.S.

patent resulting directly or indirectly from an international application filed before

November 29, 2000. Therefore, the prior art date of the reference is determined

under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C.

102(e)).

4.   Claims 1-4, 6-10 and 12-22 are rejected under 35 U.S.C. 102(e) as being

anticipated by Ogle et al. (U.S. Patent Number 6,654,790) hereinafter referred as

Ogle.

Ogle teaches the invention as claimed including a method for enabling

messaging system to use alternative message delivery mechanisms. Users may

register one or more alternative message delivery mechanism (See abstract).

As to claim 1, Ogle teaches a method for propagating presence

information, comprising:

transmitting a message from a first network entity to a second network

entity (Column 3, lines 10-58, Column 7, lines 10-Column 9, lines 25);

receiving the message using a messaging service of the second network

entity (Column 3, lines 10-58, Column 7, lines 10-Column 9, lines 25);

gathering presence information associated with the second network entity

by the messaging service (Column 3, lines 10-58, Column 7, lines 10-Column 9,

lines 25); and

providing the presence information in backward messaging to the first

network entity (Column 3, lines 10-58, Column 7, lines 10-Column 9, lines 25).

As to claim 2, Ogle teaches the method according to claim 1, further

comprising accessing a profile server associated with the second network entity,

wherein profile information accessed from the profile server governs first network

entity access rights to the presence information (Column 7, lines 35-56).

As to claim 3, Ogle teaches the method according to claim 2, wherein the

presence information provided to the first network entity is automatically attached

to the backward messaging in accordance with the first network entity access

rights (Column 8, lines 1-65).

As to claim 4, Ogle teaches the method according to claim 3, wherein the

backward messaging includes one of a read report or a delivery report (Column

8, lines 1-65).

As to claim 6, Ogle teaches a messaging system, comprising:

a first terminal coupled to transmit a message (Column 3, lines 10-58,

Column 7, lines 10-Column 9, lines 25);

a network element coupled to relay the message and to provide

acknowledgment of message receipt to the first terminal (Column 3, lines 10-58,

Column 7, lines 10-Column 9, lines 25); and

a second terminal coupled to receive the message, wherein presence

information is attached to the acknowledgment by the network element to

automatically update the first terminal with second terminal presence information

(Column 3, lines 10-58, Column 7, lines 10-Column 9, lines 25).

As to claim 7, Ogle teaches the messaging system according to claim 6,

further comprising:

a profile server coupled to provide preference information associated with

the second terminal (Column 7, lines 35-56); and

a presence server coupled to provide presence information associated

with the second terminal (Column 7, lines 35-56).

As to claim 8, Ogle teaches the messaging system according to claim 7,

wherein the network element obtains first terminal access rights to the presence

information from the profile server (Column 8, lines 1-65).

As to claim 9, Ogle teaches the messaging system according to claim 8,

wherein the network element provides presence information to the first terminal

in accordance with the first terminal access rights (Column 8, lines 1-65).

As to claim 10, Ogle teaches the messaging system according to claim 6,

wherein the network element provides acknowledgment of message receipt

using one of a read report or a delivery report (Column 8, lines 1-65).

As to claim 12, Ogle teaches a mobile terminal wirelessly coupled to a

network which includes a network element capable of accessing presence

information, the mobile terminal comprising:

a memory capable of storing at least one of a messaging module and a

presence processor (Column 3, lines 10-58, Column 7, lines 10-Column 9, lines

25);

a processor coupled to the memory and configured by the messaging

module to enable a backward message exchange with the network element

(Column 3, lines 10-58, Column 7, lines 10-Column 9, lines 25); and

a transceiver configured to facilitate the message exchange with the

network element, wherein the processor is configured by the presence processor

to display the presence information attached to the backward message (Column

3, lines 10-58, Column 7, lines 10-Column 9, lines 25).

As to claim 13, Ogle teaches the mobile terminal according to claim 12,

wherein the presence information is stored within the memory (Column 7, lines

35-56).

As to claim 14, Ogle teaches the mobile terminal according to claim 13,

wherein the presence information is displayed by a delivery report menu option of

the mobile terminal (Column 8, lines 40-Column 9, lines 52).

As to claim 15, Ogle teaches the mobile terminal according to claim 13,

wherein the presence information is displayed from any storage location within

the memory that is accessible by a display screen of the mobile terminal (Column

8, lines 40-Column 9, lines 52).

As to claim 16, Ogle teaches the mobile terminal according to claim 12, wherein the presence information is automatically displayed without user interaction (Column 8, lines 40-Column 9, lines 52).

As to claim 17, Ogle teaches the mobile terminal according to claim 16, wherein the user is provided an option to save the presence information after its automatic display (Column 8, lines 40-Column 9, lines 52).

As to claim 18, Ogle teaches a computer-readable medium having instructions stored thereon which are executable by a first mobile terminal for exchanging messages by performing steps comprising:

transmitting a message to a second mobile terminal (Column 3, lines 10-58, Column 7, lines 10-Column 9, lines 25);

receiving an acknowledgment message from a messaging service of the second mobile terminal (Column 3, lines 10-58, Column 7, lines 10-Column 9, lines 25); and

displaying presence information contained within the acknowledgment message, wherein the presence information is populated by the messaging service (Column 3, lines 10-58, Column 7, lines 10-Column 9, lines 25).

As to claim 19, Ogle teaches a server within a network used to facilitate an exchange of messages, comprising:

means for receiving a message from a first terminal (Column 3, lines 10-58, Column 7, lines 10-Column 9, lines 25);

means for extracting presence information associated with a recipient of the message (Column 3, lines 10-58, Column 7, lines 10-Column 9, lines 25); and

means for providing the presence information to the first terminal in a backward message (Column 3, lines 10-58, Column 7, lines 10-Column 9, lines 25).

As to claim 20, Ogle teaches the server according to claim 19, further comprising means for extracting profile information associated with the recipient of the message (Column 7, lines 35-55).

As to claim 21, Ogle teaches the server according to claim 20, further comprising means for filtering the presence information provided in accordance with the profile information (Column 7, lines 35-55).

As to claim 22, Ogle teaches a computer-readable medium having instructions stored thereon which are executable by a network server for facilitating messaging by performing steps comprising:

receiving messages from a first network terminal (Column 3, lines 10-58, Column 7, lines 10-Column 9, lines 25);

obtaining presence information associated with a recipient of the

messages (Column 3, lines 10-58, Column 7, lines 10-Column 9, lines 25);

formatting the presence information into a backward message in

accordance with profile information associated with the recipient of the

messages; and sending the backward message to the first network terminal

(Column 3, lines 10-58, Column 7, lines 10-Column 9, lines 25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Ogle as applied above, and further in view of Official Notice.

Ogle teaches the invention substantially as claimed including a method for

enabling messaging system to use alternative message delivery mechanisms.

Users may register one or more alternative message delivery mechanism (See

abstract).

As to claim 5, Ogle teaches the method of claim 1.

Ogle does not explicitly teach claim limitation Session initiation protocol (SIP) signaling.

However, "Official Notice" is taken that the concept and advantages of Session initiation protocol (SIP) is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ogle by adding Session initiation protocol (SIP), which would initiate an interactive user session. One would be motivated to do so to enhance the system's communication.

Claim 11 does not teach or define any new limitation other than above claim 5. Therefore, rejected for similar reasons.

6.   **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

- Smith et al. (U.S. Patent Number 7,113,979) discloses system for

  enhancing electronic messages.

- Daurensan (U.S. Patent Number 7,092,700) discloses method for

  signaling a call or a message to its addressee.

- Hammond (U.S. Patent Number 6,854,007) discloses method for

  enhancing reliability of communication with electronic messages.

- Anderson (U.S. Patent Number 6,442,600) discloses method for

  centralized storage and management of electronic messages.

- Quinn (U.S. Patent Number 5,944,786) discloses automatic notification of

  receipt of electronic mail via telephone system.

- Dumont et al. (U.S. Patent Number 7,088,993) discloses optimized

  message notification.

- Smith et al. (U.S. Patent Number 6,839,562) discloses intelligent delivery

  agent for short message distribution center.

- Smith et al. (U.S. Patent Number 6,463,462) discloses automated system

  for delivery of message and processing of message responses.

8.   Any inquiry concerning this communication or earlier communications from

the examiner should be directed to Faruk Hamza whose telephone number is

571-272-7969. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll –free).

Faruk Hamza

Patent Examiner

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SUPERVISORY PATENT EXAMINER